REMARKS

The Office Action mailed December 17, 2003 has been carefully reviewed and the foregoing amendment and following remarks have been made in consequence thereof.

Claims 1-18 are pending in this application. Claims 1-18 stand rejected.

The rejection of Claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Haq et al. "Haq", (U.S. Patent No. 6,275,812) in view of Brady et al., "Brady" (U.S. Patent 6,463,430) is respectfully traversed.

Haq describes a system and method for human resource skill management, training, career development, and deployment, linking specialties, job functions, skill sets, and experience/training profiles. The method uses skill templates that enable a systematic evaluation of employee skills. A weighting system is also used to establish the relative significance of various skills. Skills are sub-classified as per technology. An assessment of an employee's suitability for a project is based on a quantitative evaluation and not based on subjective considerations. Skills assessment metrics are also described.

Brady describes an automated method of creating or updating a database of resumes and related documents wherein a resume is defined at column 5, lines 29-31 as being, "a document that contains...information relevant to an individual's work and/or educational experience." Moreover, at column 5, lines 33-36, the term "related documents" is defined as "documents that provide additional information regarding an individuals qualifications and expertise in a particular area, e.g., journal articles, or publications." The method includes retrieving a resume or related document from a network of documents, harvesting information from specified fields of the document, classifying the information into one or more classes, determining whether the information are links to other documents, and ranking the link's according to relevancy. The resumes include one or more desired attributes, such as, technical expertise, years of work experience in an industry, or academic training (type of degree, institution where degree awarded, grade point average, etc.). Notably, Brady does not describe nor suggest any **subjective** qualities desired in a candidate, such as analytical ability, self-confidence, initiative, change orientation, and interpersonal skills. Rather, at

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column 6, lines 1-21, Brady describes that the database is updated with **objective** qualities "such as, technical expertise, years of work experience in an industry, academic training (type of degree, institution where degree awarded, grade point average, etc.)." Moreover, at column 7, lines 11-19, Brady describes that the invention provides the user with many benefits, including the fact that the "method is automated and preformed by computers", such that "the resultant database is more uniform and consistent since the extraction and classification process is free of variation from human interpretation."

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify Haq. according to the teachings of Brady. More specifically, it is respectfully submitted that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, the Federal Circuit has determined that:

> [I]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, "it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a

suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Although it is asserted within the Office Action that Haq teach the present invention except for disclosing desired qualities including at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and that Brady discloses the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, no motivation nor suggestion to combine Brady with Haq has been shown. Since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 11, 13-17, 19, and 20 be withdrawn.

Furthermore, Applicants respectfully disagree with the assertion in the Office Action that Brady discloses the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills. Rather, Brady describes automatically harvesting **objective** information from resumes retrieved from a network via a processor such that "the extraction and classification process is free of variation from human interpretation." The information includes data disclosed in specific fields of a retrieved resume, such as, "technical expertise, years of work experience in an industry, academic training (type of degree, institution where degree awarded, grade point average, etc.)." As such, this information is not "pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills" as recited in Claim 1, but, is rather objective information harvested from a resume.

Furthermore, Applicants respectfully submit that no motivation for the combination can be found within Haq and Brady, as Haq and Brady teach away from each other. For example, in contrast to Brady, Haq describes a method for human resource skill management that uses skill templates to enable a systematic evaluation of employee skills including weighting of the skills to establish the relative significance of various skills wherein an

assessment of employee suitability for a project is based on quantitative evaluation and not on a subjective consideration. More specifically, Haq describes assessing employee skills, weighting the relative values of those skills and comparing the weighted value to an ideal.

In direct contrast to Haq, Brady describes utilizing a processor to automatically harvest information from publicly available resumes without human intervention. Accordingly, Brady does not describe nor suggest normalizing desired characteristics based on a comparison to a related pre-determined desired quality. More specifically, at column 5, lines 12-18, Brady describes the following:

> a retrieved resume may provide a link to a publication directed to subject matter that is relevant to the position that is to be filled. Evaluation of the publication may show that the potential co-authors are equally or more desirable candidates, in which case the resumes for these individuals may also be sought from the Internet.

In contrast to Haq and Brady, the present invention recites, for example at page 3, lines 4-5 that "information pertaining to desired candidate qualities is gathered 44 by assessing a résumé of each candidate submitted." In contrast to this subjective approach to candidate assessment, Haq describes the assessment of employee suitability for a project is based on **quantitative evaluation** and not on a **subjective consideration**, and Brady describes that the method is automated and performed by computers and therefore the resultant database is more uniform and consistent since the extraction and classification process is free of variation from human interpretation. Accordingly, Applicants submit that Haq teaches away from Brady, and that the combination of Haq and Brady teaches away from the present invention.

If art "teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. More specifically, Applicants respectfully submit that Haq teaches away from Brady, and as such, there is no suggestion or motivation to combine Haq with Brady.

Further, and to the extent understood, no combination of Haq and Brady, describes or suggests the claimed combination, and as such, the presently pending claims are patentably distinguishable from the cited combination. Specifically, Claim 1 recites a method for determining candidates to interview that includes "providing pre-determined desired qualities for a candidate, the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills...generating a database including at least one characteristic for each individual wherein the at least one characteristic is correlative to the desired qualities...normalizing the characteristics, normalizing includes comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison...displaying results for each individual based on the normalized characteristics...and selecting at least one candidate to interview."

No combination of Haq and Brady describes or suggests a method for determining candidates to interview as recited in Claim 1. More specifically, no combination of Haq and Brady describes or suggests a method for determining candidates to interview that includes providing pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills. Additionally, no combination of Haq and Brady describes or suggests generating a database including at least one characteristic for each individual wherein the at least one characteristic is correlative to the desired qualities. Rather, Haq describes a method of optimizing the assignment of employees to positions based upon a multi-factored analysis and database and Brady describes a network spider that automatically harvests anonymous information from resumes and other documents found on the network without any human intervention. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Haq in view of Brady.

Claims 2-5 depend from independent Claim 1. When the recitations of Claims 2-5 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-5 likewise are patentable over Haq in view of Brady.

Claim 6 recites a selection system for determining candidates to interview that includes "a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two

of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills and wherein the at least one characteristic is correlative to the desired qualities...a processor programmed to...normalize the characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison...and display results for each candidate based on normalized characteristics."

Neither Haq nor Brady, considered alone or in combination, describes or suggests a selection system for determining candidates to interview as recited in Claim 6. More specifically, no combination of Haq and Brady describes or suggests a selection system for determining candidates to interview that includes a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills and wherein the at least one characteristic is correlative to the desired qualities. Rather, Haq describes a method of optimizing the assignment of employees to positions based upon a multi-factored analysis and database and Brady describes a network spider that harvests anonymous information from resumes and other documents found on the network. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 6 is patentable over Haq in view of Brady.

Claims 7-11 depend, directly or indirectly, from independent Claim 6. When the recitations of Claims 7-11 are considered in combination with the recitations of Claim 6, Applicants submit that dependent Claims 7-11 likewise are patentable over Haq.

Claim 12 recites an apparatus for screening candidates to interview that includes a processor having a memory and programmed to "generate a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and wherein the at least one characteristic is correlative to the desired qualities...normalize the characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and

assigning a value to the at least one characteristic based on the comparison...and display results for each candidate based on normalized characteristics."

Neither Haq nor Brady, considered alone or in combination, describes or suggests an apparatus for screening candidates to interview as recited in Claim 12. More specifically, no combination of Haq and Brady describes or suggests an apparatus for screening candidates to interview that includes a database having at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and wherein the at least one characteristic is correlative to the desired qualities. Rather, Haq describes a method of optimizing the assignment of employees to positions based upon a multi-factored analysis and database. Although Haq discusses a system that enables employees to assess what specific skills are needed to perform a job function, and Brady describes a system for harvesting resumes from a network of documents and extracting information from specific fields, neither Haq nor Brady describes or suggests a database having pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, nor at least one characteristic that is correlative to the desired qualities. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 12 is patentable over Haq in view of Brady.

Claims 13-18 depend, directly or indirectly, from independent Claim 12. When the recitations of Claims 13-18 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claims 13-18 likewise are patentable over Haq in view of Brady.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 1-18 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,
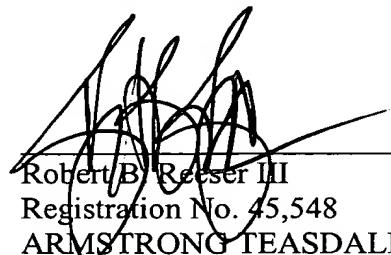
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